

REMARKS

Claims 1-12 are currently pending in the application. The foregoing separate sheets marked as "Listing of Claims" shows all the claims in the application, with an indication of the current status of each. No new matter has been added.

The claimed invention provides a system and method for market makers of one or more electronic marketplaces (e-marketplaces), providing request for quote (RFQ) processes over a network in a way that shortens the time taken to run an RFQ process without sacrificing effectiveness as a trading mechanism. In an RFQ process, a buyer 110 submits an RFQ 700 to an e-marketplace 130, preferably by using a Web browser program 112 running on a computer 111. The Web server system 131 of the e-marketplace 130 receives the RFQ 700 and posts it as a new market in the e-marketplace 130. One or more sellers 120 interested in the posted RFQ 700 may then submit one or more sell bids 142 to the e-marketplace 130 by use of a Web browser program 122 running on a computer 121. The buyer 110 who posted the RFQ 700 subsequently makes final selection of a seller from among the submitted sell bids 142.

The claimed invention also enables a buyer to research the market without actually submitting an RFQ 700 to the e-marketplace 130. Before posting the submitted RFQ 700 to potential sellers 120, as the next step 404, the e-marketplace 130 compares the RFQ and its attribute preferences against the catalog of tentative historical sell bids 900 and 1000 stored in the database 132 by using the multi-attribute match engine 234:

[A] multi-attribute matching process that enables one or more electronic marketplaces to match between one or more RFQs and one or more sell bids stored in one or more database systems.

(Claim 1, lines 34-36; *see also* Claim 12, lines 14-16) As a result of this database query 405, the match engine 134 of the e-marketplace 130 presents to the buyer 110 a

list of tentative historical sell bids 900 and 1000 that meet attribute preferences of the submitted RFQ 700:

[A] sell bid presentation process that enables one or more electronic marketplaces to present one or more sell bids that satisfy the attribute values of preference and business conditions of preference of one or more RFQs to the buyers who submitted the RFQs to one or more electronic marketplace. (Claim 1, lines 37-40; *see also* Claim 12, lines 17-19) Such sell bid aggregation is distinct from the sell bid evaluation process (*cf.* Office Action at 3), which is also an important aspect of the claimed invention.

Claims 1-12 have been rejected under 35 U.S.C. 103(a) as unpatentable over International Patent Application No. WO 97/313322 to Giovannoli in view of U.S. Patent Application No. 6,199,050 to Alaia et al. Applicant respectfully traverses. Among the reasons for traversal are (1) that features recited in the claimed invention are not taught by either reference such that no combination of the references would yield or make obvious the claimed invention, (2) that the rejection is based on an incorrect understanding of the claimed invention, and (3) that the rejection is based, at least in part, on impermissible hindsight.

Applicant respectfully submits that the disclosures of Giovannoli and Alaia et al. do not teach, among other things, a multi-attribute match engine (*see* Claim 1, lines 34-36; Claim 12, lines 14-16) or a sell bid presentation process that permits the aggregation of sell bids from multiple e-marketplaces (*see* Claim 1, lines 37-40; claim 12, lines 17-19), which are distinct and important features of the claimed invention as discussed above.

The Examiner's summary of the disclosure of Giovannola, which is not supported by reference to any passage less than seven pages in length, includes substance not taught by Giovannola. The disclosure of Giovannoli teaches a system and a method for processing requests for quotation for goods and/or services from a

buyer or supplier of goods and/or services through a computerized system forming a computer based communications network of network members by broadcasting such requests to network members of the computerized system over a conventional transmitting medium, such as the Internet, to which the computerized system may be connected. No central database of goods, prices, etc. is involved. Instead, buyers formulate requests for quotation and transmit them to the computerized network which broadcasts the requests for quotation of one or more specified standard products to prospective sellers based on filter conditions set by the buyer and/or the seller and/or the network operator. The filter-compatible sellers' responses are communicated to the prospective buyer either over the communications network or via other acceptable communications means. Their responses are processed by the quotation system and submitted to the requesting buyer. (Giovannoli, page 3)

Recognizing, at least, that Giovannola does not teach "evaluation of bids received" (Office Action at 3), the Examiner relies on Alaia et al. to make up for the deficiencies. (As discussed below, the Examiner appears incorrectly to have concluded "the evaluation of bids received in a computerized RFQ and RFQ response process" (Office Action at 3) would be analogous to a multi-attribute match engine or the aggregation of sell bids from multiple e-marketplaces, as in the claimed invention.) The disclosure of Alaia et al. teaches methods, computer program products, systems, and machine-readable media for conducting business-to-business bidding auctions for industrial purchasers. According to the disclosure of Alaia et al., a dynamic lot closing extension feature may avoid collisions in closing times of multiple lots by dynamically extending the closing time of a subsequent lot if a preceding lot's closing time is extended to be too close to the subsequent lot's then-currently scheduled closing time. Scheduled closing times can be extended with a flexible overtime feature, in which the properties of the event triggering the extension and the duration of the overtime period(s) can be tailored to a particular

auction, particular lots of products within an auction, and to the particular time within an auction process. The bidding status of a lot can be set to a "pending" status after the nominal closing time for submission of bids to allow bidders to alert the auction coordinator of technical problems in submission of bids. This allows the possibility for a lot to be return to open status for further bidding by all bidders. The auction may be paused by the auction coordinator to correct technical, market and miscellaneous problems that may arise during the course of an auction. Individual bid ceilings can be set for each bidder so that they are required to bid lower than certain thresholds determined in advance of the auction. Failsafe error detection is performed to prevent erroneous bids from entering the auction. The auction coordinator has the ability to override any erroneous bids that are entered to prevent prejudice to the auction. (Alaia et al., Abstract)

Giovannola and Alaia et al. are thus focused on executing auctions and do not provide for skipping auctions when possible, as does the claimed invention. Neither Giovannola nor Alaia et al. teaches the use of historical/tentative sell bids (which, in the claimed invention, may be supplemented by negotiation) to avoid the time-consuming process of RFQ auctions. (*Cf., as discussed above*, Claim 1, lines 34-36; Claim 12, lines 14-16) Also unlike the claimed invention, neither Giovannola nor Alaia teaches the creation of sell bids aggregating two or more bids when individual bids do not match the specification of the RFQ effectively. (*Cf., as discussed above*, Claim 1, lines 37-40; claim 12, lines 17-19)

In discussing of how Giovannola and Aiala et al. might be combined to arrive at the claimed invention, the Office Action makes it clear that the Examiner has misunderstood the claimed invention:

[I]t would have been obvious to one skilled in the art at the time of the invention to know that the mere comparative display by the RFQ system of

one or more sell bids, pursuant to the preferences and criteria established by the buyer, would aid in the evaluation of the sell bids received.

(Office Action at 3) The Office Action thus implies that the claimed invention provides for “the mere comparative display by the RFQ system of one or more sell bids, pursuant to the preferences and criteria established by the buyer.” What the claimed invention does in this regard, however, is, among other things: (a) to permit the use of historical/tentative sell bids (which may be supplemented by negotiation) to avoid the time-consuming process of RFQ auctions; and (b) to permit the creation of sell bids aggregating two or more bids when individual bids do not match the specification of the RFQ effectively. Because neither Giovannola nor Alaia et al. can do those things, combining the references would not produce the missing features.

The only passage from either reference expressly identified by the Examiner in support of the rejection does not teach the substance of the claimed invention and, in fact, serves to point out important differences:

When a bidder submits a bid, that bid is sent to the server component and evaluated to determine whether the bid is from an authorized bidder, and whether the bid has exceeded a predetermined maximum acceptable price. Bids placed by a supplier are broadcast to all connected bidders thereby enabling every participating bidder to see quickly the change in market conditions and begin planning their competitive responses.

(Alaia et al., column 4, lines 4-11, cited in the Office Action at 3) Thus, like Giovannola, Alaia et al. describe closed electronic marketplaces (“authorized bidder”), while the claimed invention concerns an open electronic marketplace in which a broader set of sellers may participate and obtain access to their historical sell bids. Also like Giovannola, Alaia et al. teach distribution “to all *connected* bidders” (emphasis added), while the claimed invention makes RFQs available without regard to whether bidders are “connected,” thus enabling all interested vendors to submit

responses, which may then be evaluated against a set of attributes. Because Giovannoli and Alaia et al. lack important features of the claimed invention, a combination of the two references would not result in the claimed invention.

As a final matter, the Office Action justifies the combination of Giovannola and Alaia et al. as follows:

Because it would have been common sense and advantageous and would have provided a more comprehensive and efficient RFQ system, it would have been obvious to one skilled in the art at the time of the invention to have added the teachings of Alaia [et al.] to those of Gio[vannola], and to have added those of Gio[vannola] to those of Alaia [et al.] for the same reasons.

(Office Action at 3) The Examiner's comments in this regard constitute impermissible hindsight as well as an improper assertion of technical fact ("would have provided a more comprehensive and efficient RFQ system") in an area of esoteric technology without support by citation of any reference work ("it would have been common sense"). (See M.P.E.P. § 2144.03, citing *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 422-21 (CCPA 1970))

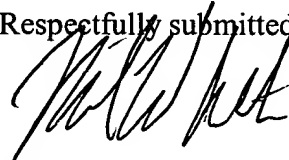
Conclusion

In view of the foregoing, it is requested that the application be reconsidered, that Claims 1-12 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at 703-787-9400 (fax: 703-787-7557; email: mike@wcc-ip.com) to discuss any other changes deemed necessary in a telephonic or personal interview.

If an extension of time is required for this response to be considered as being timely filed, a conditional petition is hereby made for such extension of time. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account 50-0510 (IBM-Yorktown).

Respectfully submitted,



Michael E. Whitham
Reg. No. 32,635

Whitham, Curtis & Christofferson, P.C.
11491 Sunset Hills Road, Suite 340
Reston, VA 20190

Please associate this
Application with
Customer No. 30743

703-787-9400
703-787-7557 (fax)